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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/809,565

03/25/2004

Anne Sabbagh

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EXAMINER

VENKAT, JYOTHSNA A

ART UNIT

PAPER NUMBER

1615

MAIL DATE

DELIVERY MODE

08/08/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/809,565

Applicant(s)

SABBAGH ET AL.

Examiner

JYOTHSNA A. VENKAT Ph. D

Art Unit

1615

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 January 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-40 and 42-77 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-40 and 42-77 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Claim 41 is canceled as per applicant's preliminary amendment dated 1/14/05. Claims 1-40 and 42-77 are pending in the application.

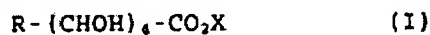
Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-21, 38, 63 and 66-71 are, drawn to

1. (currently amended) A method for complexing metal cations present in either a reducing composition for bleaching or permanently reshaping keratin fibres, or keratin fibres, wherein said reducing composition comprises at least one reducing agent, comprising the step of:

mixing said reducing composition with at least one compound of formula (I):



wherein:

- R -is a \rightarrow CH_2OH or CO_2X group, and
- X -is a hydrogen atom or a monovalent or divalent cation derived from an alkali metal, -an alkaline-earth metal, -a transition metal, -an organic amine, or an ammonium cation.

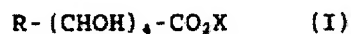
, classified in class 424, subclass 70.2.

II. Claims 22-37 and 42- 62 are, drawn to

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22. (currently amended) A Reducing composition for bleaching or permanently reshaping keratin fibres, comprising:

- a) at least one reducing agent, and
 b) at least one compound of formula (I) below:



wherein:

- R is a -CH₂OH or CO₂X group, and
- X is a hydrogen atom or a monovalent or divalent cation chosen from an alkali metal, an alkaline-earth metal, a transition metal, an organic amine, or an ammonium cation,

with the proviso that,

when said compound of formula (I) is gluconic acid or a salt thereof, said reducing agent is chosen from cysteamine or a salts or esters thereof, a sulphites, a sulphinates or a reductones, with the exception of ascorbic acid, and,

when the said compound of formula (I) is glucaric acid, said reducing agent is not cysteine or a salt thereof.

classified in class 424, subclass 70.2.

III. Claim 39 is, drawn to

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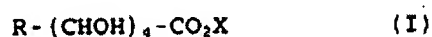
~~existing composition therefrom.~~

39. (currently amended) ~~—A kit—~~ for bleaching keratin fibres, comprising: at least two compositions A and B intended to be mixed together to obtain a ready-to-use reducing composition, ~~wherein,~~

a) at least one of the ~~said~~ compositions A and B contains at least one reducing agent; and

b) at least one of the compositions A and B contains at least one compound ~~f~~

formula (I)

~~wherein:~~

- R is a ~~—CH₂OH or CO₂X group,~~ and
- X is a hydrogen atom or a monovalent or divalent cation chosen from an alkali metal, alkaline-earth metal, ~~—a transition metal,~~ ~~—an organic amine,~~ or an ammonium cation,

with the proviso that,

when ~~said compound of formula (I)~~ is gluconic acid or a salt thereof, said reducing agent is chosen from cysteamine, or a ~~—salts or esters thereof,~~ a sulphites, a sulphinates ~~for a reductones,~~ with the exception of ascorbic acid, ~~nd,~~

when the compound is glucaric acid, said reducing agent is not cysteine or a salt thereof.

, classified in class 132, subclass 1+.

IV. Claim 40 is, drawn to

40. (currently amended) A ~~—kit—~~ for permanently reshaping keratin fibres, comprising:

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and,

b) a ready-to-use oxidizing composition C or at least two compositions D and E intended to be mixed together to obtain a ready-to-use oxidizing composition,

wherein,

(i) either said composition A or said at least one of the compositions A' and B' contains at least one

reducing agents, and

(ii) either said composition A or said at least one of the compositions A' and B' contains at least one compounds of formula (I)



wherein:

- F is a γ -CH₂OH or CO₂X group, and
- X is a hydrogen atom or a monovalent or divalent cation chosen from an alkali metal, an alkaline-earth metal, a transition metal, an organic amine, or an ammonium cation,

with the proviso that,

when said compound of formula (I) is gluconic acid or a salt thereof, said reducing agent is cysteamine

or a salt or esters thereof, a sulphites, a sulphates or a reductones, with the exception of ascorbic acid, and,

when said compound of formula (I) is glucaric acid, said reducing agent is not cysteine or a salt thereof.

classified in class 132, subclass 1+.

V. Claims 64-65 are, drawn to

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64. (new) A method of permanently reshaping keratin fibres, comprising the steps of:

a) applying to said keratin fibres a reducing composition of claim 22;

b) leaving said reducing composition on said keratin fibres for a sufficient time to obtain the desired permanent reshaping;

c) rinsing said keratin fibres to remove said reducing composition therefrom;

d) applying an oxidizing composition to said keratin fibres;

e) leaving said oxidizing composition on said keratin fibres for a sufficient time to obtain the desired reshaping;

f) rinsing said keratin fibres with water to remove said oxidizing composition therefrom;

g) washing said keratin fibres one or more times, rinsing them after each wash.

classified in class 424, subclass 70.2.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and V are directed to related to distinct method of uses. The related inventions are distinct if the (1) the inventions as claimed are either not capable of use together or can have a materially different design, mode of operation, function, or effect; (2) the inventions do not overlap in scope, i.e., are mutually exclusive; and (3) the inventions as claimed are not obvious variants. See MPEP § 806.05(j). In the instant case, the inventions as claimed do not overlap in scope since group I method does not have the steps recited in group V. Group V is drawn to method for reshaping and this method has oxidizing composition. This oxidizing composition is not present in group I. Thus the groups have different mode of operation. Art anticipating group I would not anticipate group V. Furthermore, the inventions as claimed do not

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encompass overlapping subject matter and there is nothing of record to show them to be obvious variants.

Inventions III and IV are directed to related products. The related inventions are distinct if the (1) the inventions as claimed are either not capable of use together or can have a materially different design, mode of operation, function, or effect; (2) the inventions do not overlap in scope, i.e., are mutually exclusive; and (3) the inventions as claimed are not obvious variants. See MPEP § 806.05(j). In the instant case, the inventions as claimed do not overlap in scope since kit of group III has two compositions, where as kit of group IV has four compositions. Furthermore, the inventions as claimed do not encompass overlapping subject matter and there is nothing of record to show them to be obvious variants.

Inventions I and III or IV are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another and materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the process of group I can be used by apparatus of group III or apparatus of group IV evidenced by applicants themselves.

Inventions I and II are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different designs, modes of operation, and effects (MPEP § 802.01 and § 806.06). In the instant case, the different inventions do not overlap in scope. The method of group I is different from compositions of group II and they are unrelated inventions.

Election of Species

This application contains claims directed to the following patentably distinct species belonging to compound of formula I. The species are:

1. gluconic acid, sodium gluconate, potassium gluconate, anhydrous calcium gluconate, calcium gluconate monohydrate, calcium borogluconate, magnesium gluconate, iron gluconate, manganese I gluconate, zinc gluconate or copper gluconate
2. mucic acid, the alkali metal salts of mucic acid, the alkaline-earth metal salts of mucic acid, the transition metal salts of mucic acid, the organic amine salts of mucic acid ammonium salts of mucic acids,
3. glucaric acid, the alkali metal salts of glucaric acid, the alkaline-earth metal salts of glucaric acid, the transition metal salts of glucaric acid, the organic amine salts of glucaric acid, ammonium salts of glucaric acids,
4. mannaric acid, the alkali metal salts of mannaric acid, the alkaline-earth metal salts of mannaric acid, the transition metal salts of mannaric acid, the organic amine salts of mannaric acid, ammonium salts of mannaric acids
5. mannonic acid, the alkali metal salts thereof, the alkaline-earth metal salts thereof, the transition metal salts thereof, the organic amine salts thereof and the ammonium salts thereof, and mixtures thereof
6. altronic acid, the alkali metal salts thereof, the alkaline-earth metal salts thereof, the transition metal salts thereof, the organic amine salts thereof and the ammonium salts thereof, and mixtures thereof

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7. Idonic acid, the alkali metal salts thereof, the alkaline-earth metal salts thereof, the transition metal salts thereof, the organic amine salts thereof and the ammonium salts thereof, and mixtures thereof
8. galactonic acid, the alkali metal salts thereof, the alkaline-earth metal salts thereof, the transition metal salts thereof, the organic amine salts thereof and the ammonium salts thereof, and mixtures thereof
9. talonic acid, the alkali metal salts thereof, the alkaline-earth metal salts thereof, the transition metal salts thereof, the organic amine salts thereof and the ammonium salts thereof, and mixtures thereof
10. gulonic acid, the alkali metal salts thereof, the alkaline-earth metal salts thereof, the transition metal salts thereof, the organic amine salts thereof and the ammonium salts thereof, and mixtures thereof
11. allonic acid, the alkali metal salts thereof, the alkaline-earth metal salts thereof, the transition metal salts thereof, the organic amine salts thereof and the ammonium salts thereof, and mixtures thereof.
12. altraric acid, the alkali metal salts thereof, the alkaline-earth metal salts thereof, the transition metal salts thereof, the organic amine salts thereof and the ammonium salts thereof, and mixtures thereof.
13. idaric acid, the alkali metal salts thereof, the alkaline-earth metal salts thereof, the transition metal salts thereof, the organic amine salts thereof and the ammonium salts thereof, and mixtures thereof

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14. talaric acid, the alkali metal salts thereof, the alkaline-earth metal salts thereof, the transition metal salts thereof, the organic amine salts thereof and the ammonium salts thereof, and mixtures thereof
15. gularic acid, the alkali metal salts thereof, the alkaline-earth metal salts thereof, the transition metal salts thereof, the organic amine salts thereof and the ammonium salts thereof, and mixtures thereof
16. allaric acid, the alkali metal salts thereof, the alkaline-earth metal salts thereof, the transition metal salts thereof, the organic amine salts thereof and the ammonium salts thereof, and mixtures thereof.

The species are independent or distinct because claims to the different species recite the mutually exclusive characteristics of such species. In addition, these species are not obvious variants of each other based on the current record.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1-3, 7-24, 29-40 and 42-77 are generic.

There is an examination and search burden for these patentably distinct species due to their mutually exclusive characteristics. The species require a different field of search (e.g., searching different classes/subclasses or electronic resources, or employing different search queries); and/or the prior art applicable to one species would not likely be applicable to another species; and/or the species are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species to be examined even though the requirement may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

The election of the species may be made with or without traverse. To preserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the election of species requirement, the election shall be treated as an election without traverse. Traversal must be presented at the time of election in order to be considered timely. Failure to timely traverse the requirement will result in the loss of right to petition under 37 CFR 1.144. If claims are added after the election, applicant must indicate which of these claims are readable on the elected species.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the species unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other species.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141.

Restriction for examination purposes as indicated is proper because all these inventions listed in this action are independent or distinct for the reasons given above and there would be a

serious search and examination burden if restriction were not required because one or more of the following reasons apply:

- (a) the inventions have acquired a separate status in the art in view of their different classification;
- (b) the inventions have acquired a separate status in the art due to their recognized divergent subject matter;
- (c) the inventions require a different field of search (for example, searching different classes/subclasses or electronic resources, or employing different search queries);
- (d) the prior art applicable to one invention would not likely be applicable to another invention;
- (e) the inventions are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a invention to be examined even though the requirement may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse. Traversal must be presented at the time of election in order to be considered timely. Failure to timely traverse the requirement will result in the loss of right to petition under 37 CFR 1.144. If claims are added after the election, applicant must indicate which of these claims are readable on the elected invention.

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If claims are added after the election, applicant must indicate which of these claims are readable upon the elected invention.

Should applicant traverse on the ground that the inventions are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and the product claims are subsequently found allowable, withdrawn process claims that depend from or otherwise require all the limitations of the allowable product claim will be considered for rejoinder. All claims directed to a nonelected process invention must require all the limitations of an allowable product claim for that process invention to be rejoined.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103 and 112. Until all claims to the elected product are found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained.

Withdrawn process claims that are not commensurate in scope with an allowable product claim will not be rejoined. See MPEP § 821.04(b). Additionally, in order to retain the right to rejoinder in accordance with the above policy, applicant is advised that the process claims should be

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amended during prosecution to require the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.** Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

Due to complexity of the action, examiner submitted Election Requirement in writing in lieu of calling applicants' attorney.


Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JYOTHSNA A. VENKAT Ph. D whose telephone number is 571-272-0607. The examiner can normally be reached on Monday-Friday, 10:30-7:30:1st Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, MICHAEL WOODWARD can be reached on 571-272-8373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


JYOTHSNA A VENKAT Ph.D
Primary Examiner
Art Unit 1615
